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10/573,066

10/24/2006

Ulrike Wachendorff-Neumann

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10/15/2008

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EXAMINER

MANOHAR, MANU M

ART UNIT

PAPER NUMBER

1617

MAIL DATE

DELIVERY MODE

10/15/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/573,066

**Applicant(s)**

WACHENDORFF-NEUMANN ET AL.

**Examiner**

MANU MANOHAR

**Art Unit**

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 6-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/30/2007</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **The status of the Claim**

Claims 1-14 are pending in this application. Original claims 1-14 were subjected to the election of species. The details are below.

### **Election and Restriction**

Applicant's election of Group I (Claims 1-11), with traverse in the reply filed on July 18, 2008 is acknowledged. For the species election requirement the applicants elect the compound N-(3',4'-dichloro-5-fluoro-1,1'-biphenyl-2-yl)-3-(difluoromethyl)-1-methyl-1H-pyrazole-4-carboxamide. The traversal is on the ground(s) that all the groups Group I, II and III share a special technical feature since each of the groups recite synergistic fungicidal active compound. This is not found persuasive because of the rationale were presented in the restriction requirement mailed June 19, 2008. Inventions I claims 1-11 drawn to compounds and compositions and inventions II, claim 12-13 are drawn to method of use and Invention III claim 14 is drawn to method of making. The inventions listed as Groups I to III do not relate to a single general inventive concept and they lack the same special technical features. The compounds are related to derivatives of carboxamide and as stated in the correspondence for election restriction requirement and these derivatives has already been described in the prior art. Therefore, unity of invention is lacking and restriction of the invention in accordance with the rules of unity of invention is proper. Hence the requirement of

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restriction and election of species is still deemed proper and is therefore made FINAL.

In response to applicant's election Group I (Claims 1-11), Group II (claim 12-13) and Group III (claim 14) have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicants have elected Group I (Claims 1-11) with traverse. However claims 1-5 which read on the elected species are only considered in the application. Claims 6- 11 which are not read on elected species are withdrawn from consideration.

### **Priority**

The application is with a filing date of October 24, 2006. This application is a 371 of PCT/EP04/10830 with filing date of September 28, 2004. The examiner acknowledges that the effective US filing date is September 28, 2004.

### ***Claim Objections***

Claim 5 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claims of 1 and 3. See MPEP § 608.01(n). Accordingly, the claim 5 not been further treated on the merits.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

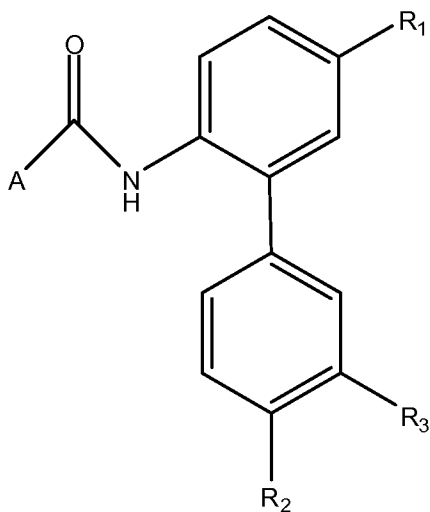
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious

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at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

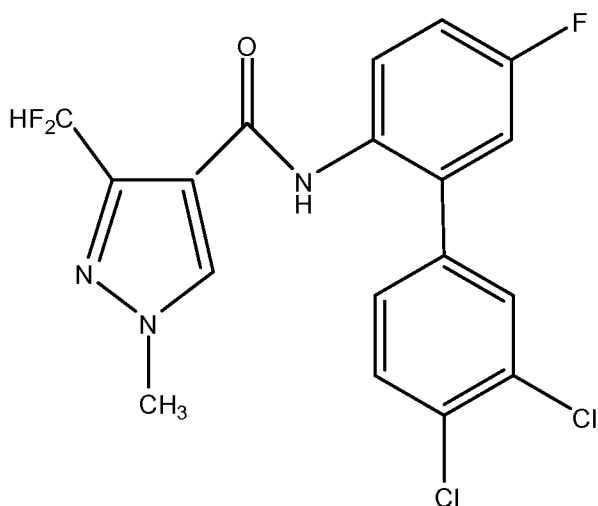
Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over  
Bruns et al, US 2002/0198222 (Listed in Information Disclosure Statement) in view of  
Dunkel et al, DE 102 15 292 (Listed in Information Disclosure Statement).

Claim 1 is drawn to the synergistic fungicidal active compound combinations  
comprising a carboxamide of the general formula (I) (group 1) and a compound from the  
group 2-23.



Applicant elect the following species N-(3',4'-dichloro-5-fluoro-1,1'-biphenyl-2-yl)-  
3-(difluoromethyl)-1-methyl-1-pyrazole-4-carboxamide from the general structure,

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and a compound tebeconazole.

Claims 2-4 are drawn to the elected species as shown on the structure above.

Bruns et al teaches the use of combination of compounds as microbicides and this include derivatives of carboxamide and the co-components tebuconazole (Page 1 paragraph [0001], page 4 paragraphs [0080, 0082, and 0088]. This reference does not specifically teach the specific carboxamide derivative N-(3',4'-dichloro-5-fluoro-1,1'-biphenyl-2-yl)-3-(difluoromethyl)-1-methyl-1H-pyrazole-4-carboxamide. Dunkel et al teaches the structure of this specific compound (page 19 compound 11 in the table)

It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to substitute the carboxamide derivative as taught by Burns et al with specific carboxamide derivatives as taught by Dunkel et al.

It is known in the art that the derivatives of carboxamides in combination of co-components like tebuconazole can be used as microbicidal agent because the combination are highly effective in controlling the pathogenic organisms. Hence one of

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the ordinary skills in the art would be motivated to combine the different agents like carboxamide derivatives as taught by Burns et al with co-component like tebuconazole as taught by Dunkel et al to prepare effective synergistic fungicidal compositions. The teaching of Burns et al with the modification of Dunkel et al makes it prima facie obvious to one of ordinary skill in the art at the time of invention to develop the combinations as above.

### ***Conclusions***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MANU MANOHAR whose telephone number is (571)270-5752. The examiner can normally be reached on Mon - Thu 9.00AM to 4.00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, PATRICK Nolan can be reached on 571-272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO

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Customer Service Representative or access to the automated information system, call  
800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MANU MANOHAR  
Examiner  
Art Unit 4161

MM

/Ashwin Mehta/  
Primary Examiner, Technology Center 1600